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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,874	02/04/2002	Hans-Joachim Timpe	A34880-065838.0325	4791
7590	04/06/2004			
Paul W. Busse Faegre & Benson LLP 2200 South Seventh Street Minneapolis, MN 55401-3901			EXAMINER GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,874

Applicant(s)

TIMPE ET AL.

Examiner

Barbara Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-16, 27, 28, 31, 32 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-16, 27-28, 31-32, 37-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed January 12, 2004 has been received and entered.
2. Claims 1-7, 9-16, 27-28, 31-32 and 37-40 are present.  
Claims 8, 17-26, 29-30 and 33-36 were canceled.
3. The objection to claim 11 is withdrawn.  
The rejection under 35 USC 102(a) over Sawada et al. (EP 1 106 381 A1) is withdrawn in light of the amendment.
4. The indicated allowability of claims 1-7, 9-10, 12-15, 32 is withdrawn in view of the rejection over Hauck et al. (US 6 309 792 B1) in view of Sawada et al. (EP 1 106 381 A1).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 1-7, 9-16, 27-28, 31-32, 37-40 are rejected under 35 U.S.C. 103(a) as being obvious over Hauck et al. (US 6,309,792 B1) in view of Sawada et al. (EP 1 106 381 A1).

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a. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

b. The IR-sensitive composition of Hauck et al. meets the present limitations for the infrared radiation sensitive composition. Specifically the composition of Hauck et al. contains an initiator system comprising at least one compound capable of absorbing IR light, at least one compound capable of producing radicals, at least one polycarboxylic acid (claim 1), a polymeric binder and at least one component selected from the group consisting of unsaturated free radical polymerizable monomers oligomers (claim 9). See also column 3, line 40 - column 14, line 32 and claims 2-8, 10-

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32. According to Hauck et al., all polymers or polymer mixtures known in the art can be used as the polymeric binder including acrylic acid copolymers and methacrylic acid copolymers. Preferably when polymer mixtures are used, the arithmetic average of the individual acid numbers be  $>70$  mg KOH/g (column 4, lines 29-45). The acrylic acid copolymers and methacrylic acid copolymers meet the present limitations for the first polymeric binder. Polyethers are not taught specifically as suitable polymer binders however it would have been obvious to one of ordinary skill in the art to use polyethers in the polymeric mixture of Hauck et al. based on the teachings of Sawada et al. Polyethers are incorporated into a photosensitive layer to enhance the strength of the hardened layer (EP 1 106 381 A1; page 28, [0173]).

c. Therefore it would have been obvious to one of ordinary skill in the art to coat a substrate with an IR layer comprising at least one compound capable of absorbing IR light, at least one compound capable of producing radicals, at least one polycarboxylic acid (claim 1), at least one component selected from the group consisting of unsaturated free radical polymerizable monomers oligomers and a polymeric binder mixture comprising an acrylic acid copolymer and a polyether with reasonable expectation of obtaining a printing plate precursor with enhanced strength of the hardened layer based on the teachings of Hauck et al. and Sawada et al.

### ***Response to Arguments***

7. Applicant's arguments filed January 12, 2004 have been fully considered but they are not persuasive because in light of the new rejection under 35 USC 103 presented above.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Barbara Gilliam*

Barbara Gilliam  
Examiner  
Art Unit 1752  
April 2, 2004

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